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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,109	09/18/2003	Hyuk-Soo Son	0100-P0013A	6131
66837	7590	10/17/2007		
HYUN JONG PARK 41 WHITE BIRCH ROAD REDDING, CT 06896-2209			EXAMINER WHIPKEY, JASON T	
			ART UNIT	PAPER NUMBER
			2622	
			MAIL DATE	DELIVERY MODE
			10/17/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	Application No. 10/665,109	Applicant(s) SON, HYUK-SOO	
	Examiner Jason T. Whipkey	Art Unit 2622	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 September 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____
 Claim(s) objected to: 13-15.
 Claim(s) rejected: 1-12 and 16.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attachment.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
 13. ☐ Other: _____.

DETAILED ADVISORY ACTION

Response to Arguments

1. Applicant's arguments filed September 24, 2007, have been fully considered but they are not persuasive.

The claims in the instant application were rejected using the Berstis, Endo, Anderson, and Nakamura references, all of which have effective filing dates prior to the effective filing date of the instant application but after the foreign priority date of the instant application.

In the remarks, Applicant asserts, "the effective date of the present application of the applicant is the date of invention. It is well established that the applicant can rely on foreign priority under §119(a) to show an earlier date of invention which antedates the U.S. filing date of the application of the applicant" (emphasis original).

Applicant is incorrect about the effective date of the instant application.

The date of invention of the instant application is considered to be September 22, 2003, because Applicant has failed to submit proper evidence otherwise. While Applicant has submitted a foreign priority document filed with the Korean Industrial Property Office on September 19, 2002, the document is not in the English language. 35 U.S.C. § 119(b)(3) states:

The Director may require a certified copy of the original foreign application, specification, and drawings upon which it is based, a translation if not in the English language, and such other information as the Director considers necessary. Any such certification shall be made by the foreign intellectual property authority in which the foreign application was filed and show the date of the application and of the filing of the specification and other papers. (Emphasis added)

The Director has made such a requirement, which has been promulgated at 37 C.F.R. § 1.55(a)(4), which states, "An English language translation of a non-English language foreign

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application is not required except ... [w]hen necessary to overcome the date of a reference relied upon by the examiner”.

Regarding perfecting a foreign priority date, also see MPEP § 706.02(b).

Applicant also argues:

Before a patent application is published, the records of a patent application are kept in secrecy and not open to the general public. Therefore, no one except the examiners (including employees of any of the three assignee corporations) can have access to all of these three references in order to combine the teachings thereof to reach the present invention as claimed. ... Hence, a person of ordinary skill in the art (even any employee of one of these corporations who may in certain occasions have access to the contents of the patent application which is particularly assigned to their own corporation) cannot look at the relevant teachings contained in all of these three references.

Therefore, without having access to the references, one of ordinary skill in the art can neither combine the teachings of such references nor have any motivation to do so. Accordingly, the rejection of **claims 1-7 and 16** under 35 U.S.C. 103(a) (based on all later published or patented 102(e) references) over the combination of Berstis, Endo, and Anderson is improper and should be withdrawn. (Emphasis original)

This argument is spurious. 35 U.S.C. § 102(e) entitles a person to a patent unless “the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent”. In order to reject a claim, the statute does not require that publication occur before the invention by the applicant for patent; it only requires that the invention be described in a previously filed application.

The Supreme Court has authorized 35 U.S.C. § 103 rejections based on 35 U.S.C. § 102(e). See MPEP § 2136.02.

For these reasons, the rejections stand.

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Conclusion

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Whipkey, whose telephone number is (571) 272-7321. The examiner can normally be reached Monday through Friday from 9:00 A.M. to 5:30 P.M. eastern daylight time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lin Ye, can be reached at (571) 272-7372. The fax phone number for the organization where this application is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JTW

JTW

October 2, 2007



LIN YE

SUPERVISORY PATENT EXAMINER